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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,177	05/28/1999	HIROHIKO ITOH	35.G1549-CI	7620

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No. 09/322,177	Applicant(s) ITOH, HIROHIKO
Office Action Summary	Examiner Douglas Q. Tran	Art Unit 2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2002* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☒ Certified copies of the priority documents have been received in Application No. *08/528,423* .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Continued Prosecution Application

1.   The request filed on 10/4/02 for a Continued Prosecution Application (CPA) under 37

CFR 1.53(d) based on parent Application No. 09/322,177 is acceptable and a CPA has been

established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3.   Claims 16, 19, 23, 26, 30 , and 33 are rejected under 35 U.S.C. 102(e) as being

anticipated by Yaguchi et al. (US Patent No. 5,579,419).

As to claim 16, Yaguchi teaches that:

A printer (2 in fig. 1) that prints an image on a recording sheet based on image data;

A loading unit (i.e., the external storage device 6 in fig. 6) that receives a detachable

storage medium (col. 12, lines 42-46), the detachable storage medium having stored therein

image data and sheet processing information (note: the mark sheet, which is from the magnetic

optical disk inserted into the external storage device 6, includes image data that classified from

index cells 1101 and sheet processing information that is classified from 1105-1108, col. 16,

lines 39-67 and col. 17, lines 11-27)

A controller (i.e., CPU 516) that controls the printer so as to print an image on the recording sheet based on objective image data stored in the detachable storage medium in accordance with the sheet processing information stored with the objective image data in the detachable storage medium loaded in the loading unit (col. 18, lines 13-33).

As to claim 19, Yaguchi teaches that the sheet processing information is stored in the detachable storage medium by an apparatus other than the image processing apparatus (i.e., reading unit 1 in fig. 1, col. 16, line 65 to col. 17, line 1).

As to claims 23, 26, 30, and 33, Yaguchi teaches the method and program are performed by the apparatus claims 16 and 19 as indicated above.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 17-18, 20-21, 24-25, 27-28, 31-32, 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yaguchi, as applied to claims 16, 23, 30, and Takayanagi (US Patent No. 5,680,226).

As to claims 17-18 and 20-21, Yaguchi teaches the limitations in claim16 above.

Although Yaguchi does not teach sheet processing information including the setting whether sorting of recording sheets, stapling of sheets, a number of copies or pages, double-sided

or single-sided printing of the image. Such above limitations, which are well known in the prior art, are the settings that are prepared and generated from the host computer and these setting functions that are performed in the conventional printer. Such limitations would have been obvious in the printing system of Yaguchi. Since CPU 516 of Yaguchi receives a command for retrieving/printing data in data from external storage device (col. 13, lines 13-18) and printing setting for print out the image to the printer (col. 13, lines 34-37), Yaguchi would include the optional setting for sorting of recording sheets, stapling of sheets, a number of copies or pages, double-sided or single-sided printing of the image. Furthermore, Takayanagi teaches the image data file, stored in the hard disk, including image data and the attribute information, which have printing options, is performed by the printer (col. 6, lines 21-40).

It would have been obvious to have modified the printing command in the printing system of Yaguchi in order to include the options of the printing commands as taught by Takayanagi. The suggestion for modifying the system of Yaguchi can be reasoned by one of ordinary skill in the art as set forth by Takayanagi because such a modifying system including the options for printing command would give the printing system of Yaguchi a flexible selection for printing the document in the printer.

As to claims 24-25, 27-28, the combination of Yaguchi and Takayanagi teaches the methods are performed by the apparatus claims 17-18 and 20-21 as indicated above.

As to claims 31-32, and 34-35, the combination of Yaguchi and Takayanagi teaches the programs for performing the methods claims 24-25, and 27-28 as indicated above.

6.   Claims 22, 29, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the

combination of Yaguchi and Takayanagi.

As to claim 22, Yaguchi teaches that:

A printer (2 in fig. 1) that prints an image on a recording sheet based on image data;

A loading unit (i.e., the external storage device 6 in fig. 6) that receives a detachable

storage medium (col. 12, lines 42-46), the detachable storage medium having stored therein

image data and sheet processing information (col. 12, lines 56-58; note: file data would include

image data and sheet processing information from reader portion 1; and the mark sheet is also

called sheet processing information which is described in col. 16, line 65 to col. 17, line 1); and

A controller (i.e., CPU 516) that controls the printer such that the image is printed on the

recording sheet in accordance with the sheet processing information stored in the detachable

storage medium loaded in the loading unit (col. 17, lines 7-27).

Although Yaguchi does not teach sheet processing information including the setting

whether double-sided or single-sided printing of the image. Such above limitations, which are

well know in the prior art, are the settings which are prepared and generated from the host

computer and these setting functions are performed in the conventional printer when the printer

receives the instructions from the host side either via directly connection network or via

indirectly by the floppy disk. Such limitations would have been obvious in the printing system of

Yaguchi. Since CPU 516 of Yaguchi receives a command for retrieving/printing data in data

from external storage device (col. 13, lines 13-18) and printing setting for print out the image to

the printer (col. 13, lines 34-37), Yaguchi would include the optional setting for double-sided or

single-sided printing of the image. Furthermore, Takayanagi teaches the image data file, stored in

the hard disk, including image data and the attribute information, which has printing options, is

performed by the printer (col. 6, lines 21-40).

It would have been obvious to have modified the printing command in the printing

system of Yaguchi in order to include the options of the printing commands as taught by

Takayanagi. The suggestion for modifying the system of Yaguchi can be reasoned by one of

ordinary skill in the art as set forth by Takayanagi because such a modifying system including

the options for printing command would give the printing system of Yaguchi a flexible selection

for printing the document in the printer.

As to claim 29, the combination of Yaguchi and Takayanagi teaches the method is

performed by the apparatus claim 22 as indicated above.

As to claim 36, the combination of Yaguchi and Takayanagi teaches the program for

instructing the method claim 29 as indicated above.

Response to Arguments and Amendment

7.   Applicant's arguments filed 10/04/02 have been fully considered but they are not

persuasive.

Applicant asserted in page 10 and 11 that: " Nowhere does the Yaguchi '419 patent

disclose or suggest the use of sheet processing information stored in a detachable storage

medium, as disclosed and claimed in the present application (Claims 16, 23, and 30). Nor does

the Yaguchi '419 patent disclose or suggest the use of a detachable storage medium having

stored therein information as to whether double-sided or single-sided printing is to be performed

by a printer, as disclosed and claimed in the present application (claim 22, 29, and 36)." In reply,

Yaguchi clearly teaches a printed mark sheet, which is stored in magnetic-optical disk (i.e., the detachable medium) including image data which is one of index cells 1101 and information how to print the mark sheet (i.e., sheet processing information) 1105 –1108 (col. 16, lines 57-64 and col. 18, lines 13-33).

Although Yaguchi does not teach sheet processing information including the setting whether sorting of recording sheets, stapling of sheets, a number of copies or pages, double-sided or single-sided printing of the image. Such above limitations, which are well know in the prior art, are the settings that are prepared and generated from the host computer and these setting functions that are performed in the conventional printer. Such limitations would have been obvious in the printing system of Yaguchi. Since CPU 516 of Yaguchi receives a command for retrieving/printing data in data from external storage device (col. 13, lines 13-18) and printing setting for print out the image to the printer (col. 13, lines 34-37), Yaguchi would include the optional setting for sorting of recording sheets, stapling of sheets, a number of copies or pages, double-sided or single-sided printing of the image. Furthermore, Takayanagi teaches the image data file, stored in the hard disk, including image data and the attribute information, which have printing options, is performed by the printer (col. 6, lines 21-40).

Yaguchi also teaches that a loading unit (i.e., the external storage device 6 in fig. 6) that receives a detachable storage medium (col. 12, lines 42-46), the detachable storage medium having stored therein image data and sheet processing information (col. 12, lines 56-58; note: file data would include image data and sheet processing information from reader portion 1; and the mark sheet is also called sheet processing information which is described in col. 16, line 65 to col. 17, line 1); and a controller (i.e., CPU 516) that controls the printer such that the image is

printed on the recording sheet in accordance with the sheet processing information stored in the

detachable storage medium loaded in the loading unit (col. 17, lines 7-27).

For the above reasons, it is believed that the cited prior art fully discloses the claimed

invention and the rejection stand.

Contact information

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or
E-mail address is Douglas.tran@uspto.gov.
Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Nov. 01,   2002

GABRIEL GARCIA
PRIMARY EXAMINER